

*#9
4.12.03*

DOCKET NUMBER 14114.0353U2
PATENT
SERIAL NO. 09/937,862

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) Group Art: 1648
OBERSTE *et al.*)
Serial No. 09/937,862) Examiner: Shanon A. Foley
Filed: September 28, 2001)
For: "TYPING OF HUMAN ENTEROVIRUSES") Confirmation No. 8841

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

NEEDLE & ROSENBERG, P.C.
Suite 1200, The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811

Date: April 18, 2003

Sir:

This Response to a Restriction Requirement filed under is responsive to the Restriction Requirement dated December 18, 2002.

The PTO requires the restriction of the claims in the above-identified application into one of the following four groups of claims:

Group I, claim(s) 1-11, drawn to a method for detecting the presence of an enterovirus. If applicant elects this group, applicant is required to elect a single pair of oligonucleotides from

DOCKET NUMBER 14114.0353U2
PATENT
SERIAL NO. 09/937,862

the following list: SEQ ID NO: 3, SEQ ID NO: 4, SEQ ID NO: 9, SEQ ID NO: 19, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 80, SEQ ID NO: 81, SEQ ID NO: 82, SEQ ID NO: 83, SEQ ID NO: 84, SEQ ID NO: 85, and SEQ ID NO: 86.

Group II, claim(s) 12-29, drawn to a method of typing an enterovirus. If applicant elects this group, applicant is required to elect a single pair of oligonucleotides from the following list: SEQ ID NO: 3, SEQ ID NO: 4, SEQ ID NO: 9, SEQ ID NO: 19, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 80, SEQ ID NO: 81, SEQ ID NO: 82, SEQ ID NO: 83, SEQ ID NO: 84, SEQ ID NO: 85, and SEQ ID NO: 86.

Group III, claim(s) 30-33, drawn to an oligonucleotide. If applicant elects this group, applicant is required to elect a single oligonucleotide from the following list: SEQ ID NO: 3, SEQ ID NO: 4, SEQ ID NO: 9, SEQ ID NO: 19, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 80, SEQ ID NO: 81, SEQ ID NO: 82, SEQ ID NO: 83, SEQ ID NO: 84, SEQ ID NO: 85, SEQ ID NO: 86, or a complementary oligonucleotide to any single SEQ ID NO.

Group IV, claim(s) 34-46, drawn to a mixture of oligonucleotides. If applicant elects this group, applicant is required to elect a single mixture of oligonucleotides from groups A-D:

- | | | | | | | | |
|----|---------------|----|--------------|----|---------------|----|---------------|
| A) | SEQ ID NO: 80 | B) | SEQ ID NO: 3 | C) | SEQ ID NO: 83 | D) | SEQ ID NO: 19 |
| | SEQ ID NO: 81 | | SEQ ID NO: 4 | | SEQ ID NO: 84 | | SEQ ID NO: 20 |
| | SEQ ID NO: 82 | | SEQ ID NO: 9 | | SEQ ID NO: 85 | | SEQ ID NO: 21 |
| | | | | | SEQ ID NO: 86 | | SEQ ID NO: 22 |

Applicant's provisionally elect Group I with traverse.

DOCKET NUMBER 14114.0353U2
PATENT
SERIAL NO. 09/937,862

With regard to the requirement that applicants elect a single primer pair, applicants specifically traverse this requirement.

Applicants submit that the present restriction requirement by the Examiner is improper. As outlined in the MPEP § 803.04, "despite the fact that nucleotide sequences encoding different proteins are structurally distinct chemical compounds ... the Commissioner has decided *sua sponte* to partially waive the requirements... and permit a reasonable number of such nucleotide sequences to be claimed in a single application... It has been determined that normally ten sequences constitute a reasonable number for examination purposes." Accordingly, despite the fact that the Group I may include multiple primers, at least 10 should be examined together.

Thus, according to internal USPTO procedures as recited in the MPEP, applicants believe they are entitled to have at least the primers comprising SEQ ID NO: 19, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 81, SEQ ID NO: 82, SEQ ID NO: 83, SEQ ID NO: 84, SEQ ID NO: 85, and SEQ ID NO: 86 examined in this application. Therefore applicants provisionally elect the Group I with the primers comprising SEQ ID NO: 19, SEQ ID NO: 20, SEQ ID NO: 21, SEQ ID NO: 22, SEQ ID NO: 81, SEQ ID NO: 82, SEQ ID NO: 83, SEQ ID NO: 84, SEQ ID NO: 85 and SEQ ID NO: 86. If applicants' understanding of the rules in regard to the ten-sequence rule is incorrect, an explanation of the correct rule would be greatly appreciated and is respectfully requested.

DOCKET NUMBER 14114.0353U2
PATENT
SERIAL NO. 09/937,862

Furthermore, since claim 1 is generic to the primers comprising the sequences listed in the SEQ ID NOS recited in dependent claims 3-8, applicants respectfully assert that if any election among the primer pairs is required that it should be a species election only. With this understanding of the law, applicants make a provisional species election of the primers comprising SEQ ID NO: 22 and SEQ ID NO: 19. Applicants are also entitled to examination of a reasonable number of the claimed sequences upon finding a generic claim patentable. If applicants' understanding of the rules in regard to species elections is incorrect, an explanation of the correct rules would be greatly appreciated and is respectfully requested.

If the Examiner finds that both of the above provisional elections are not in keeping with the applicable law, applicants provisionally elect Group I with the primers comprising SEQ ID NO:22 and SEQ ID NO:19 with traverse.

For the above reasons, reconsideration or withdrawal of the restriction requirement is requested.

DOCKET NUMBER 14114.0353U2
PATENT
SERIAL NO. 09/937,862

A fee in the amount of \$930.00 (in payment of a three-month extension of time) is to be charged to a credit card, and such payment is authorized by the signed, enclosed document entitled Credit Card Payment Form PTO 2038. However, the Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

Gwendolyn D. Spratt
Gwendolyn D. Spratt
Registration No. 36,016

NEEDLE & ROSENBERG, P.C.
The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811
404/688-0770

CERTIFICATE OF SERVICE VIA FACSIMILE

I hereby certify that this correspondence is being transmitted, via facsimile to: Commissioner of Patents, Fax No. 703-308-4242, on the date shown below.

Gwendolyn D. Spratt
Gwendolyn D. Spratt

Date

4-18-03